

REMARKS

Claims 1-3 and 5-17 are pending in this application. Claims 5-8 have been withdrawn from consideration. Claim 17 has been added. No new matter has been added by way of this new claim because the present specification at page 9, lines 7-9 supports this new claim.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 103(a)

Claims 1-3 and 9-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ebnesajjad et al. (U.S. Patent Number 5,683,639; hereinafter "Ebnesajjad '639"). Applicants respectfully traverse.

Inapplicable Case Law and Size Is Not A Routine Skill In This Art

First, the cited *In re Rose* decision is inapplicable to the instant situation. 105 USPQ 237. The Office Action accounts for Applicants' claimed feature of size by stating, "A change in size is generally recognized as being within the level of ordinary skill in the art." (See page 3 of the March 3rd Office Action, and page 2 of the July 23rd Advisory Action). Applicants respectfully submit that application of this case is inappropriate for the instant situation.

In re Rose is a fact-specific decision, whereby one of ordinary skill in the art deals with the art of lumber. Thus, the facts (i.e., the technology) is quite different from the instant case. Further, the CCPA refers to *In re Yount* when discussing size as ordinarily not being a matter of invention. 105 USPQ at 240. In the *Yount* decision, the CCPA referred to *In re Kirke* when stating that "mere size is not ordinarily a matter of invention". 80 USPQ 141, 143 (citing *In re Kirke*, 5 USPQ 539). However, in referring to size as not a matter of invention, the *Yount* court also referred to how the "appellant by his own specification teaches that small bags are the equivalent of large bags, he is not in a favorable position to argue for any invention in one as distinguished from the other." 80 USPQ at 143 (citing *In re Ayres*, 29 USPQ 424 and *In re Withington*, 41 USPQ 742). Based on these facts and application of principles, the *In re Rose* decision is being incorrectly applied to the present invention, and that one of ordinary skill in the PTFE molded article art would not consider size as a routine skill. Thus, Applicants respectfully submit that not all instantly claimed features of the present invention can be accounted for by application of the *In re Rose* case.

Further, one of ordinary skill in the art understands the problem that a bigger article deforms during sintering due to the weight of the article itself. Accordingly, Applicants respectfully maintain their position that the present invention is patentably distinguishable from the cited Ebnesajjad '639 reference for the reasons stated in

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Applicants' Reply After Final Under 37 C.F.R. § 1.116 (dated July 10, 2003). Therefore, Applicants respectfully submit that size is not a routine skill in the art, and further request reconsideration of their previous remarks as set forth in their July 10th reply as evidence of patentability of the present invention.

Not All Requirements for a Prima Facie Case of Obviousness Have Been Satisfied

Applicants also respectfully submit that a *prima facie* case of obviousness has not been formed with respect to the Ebnesajjad '639 reference because not all requirements for a *prima facie* case of obviousness have been satisfied.

U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Here, in applying case law such as *In re Vaeck* and *In re Kotzab*, a *prima facie* case of obviousness has not been established. This is because Ebnesajjad '639 fails to disclose or suggest how to make a PTFE cylinder having a length of at least 800 mm as instantly claimed. As mentioned, the cited *Rose* is inapplicable because size is involves more than a routine skill in the pertinent art. Applicants further submit the features of the other pending claims are not disclosed by the Ebnesajjad '639 reference. For example, the cited reference fails to disclose all features of new claim 17.

Thus, Applicants respectfully submit that not all requirements for a *prima facie* case of obviousness have been satisfied. Reconsideration and withdrawal of this rejection is respectfully requested.

Evidence of Unexpected Results of the Present Invention

Applicants respectfully submit that the present invention has achieved unexpected results, whereby these unexpected results rebut any asserted *prima facie* case of obviousness.

For instance, the present invention has achieved the unexpected advantage of avoiding deformation problems that occur when producing PTFE articles of this large size. As shown in Comparative Examples 1-3 of the present specification, when the height of the article is large, the load at unit area of base or bottom of the article is high (for instance, see page 14, lines 15-17 of the specification) so that the article deforms during the sinter. The resulting deformation is due to

the weight of the article itself. In contrast, the present invention has achieved a large PTFE molded article block having less distortion and small strain is produced (see Examples in specification).

Also in contrast to the present invention, an attempt to follow the procedures of Ebnesajjad '639 in order to obtain a cylindrically-shaped product having a length as instantly claimed necessarily results in a defective product which necessarily has melt-viscosity and block deformation properties outside the parameters as defined in the present claims (i.e., see pending claim 1). Such deformations are similar or the same as the Comparative Examples of the present specification. In support of Applicants' position, Applicants respectfully refer the Examiner to Exhibit A (as attached to the July 10th Reply), which shows that a large billet of Ebnesajjad '639 would exhibit a larger deformation amount than the deformation amount (that is, 7%) defined in the presently pending claim 1.

As can be seen from Exhibit A, if the billet of Ebnesajjad '639 has the same large size as in Example 1 of the present specification (height: 1000 mm, diameter: 420 mm), such a large billet would deform using "Procedure D," just as Comparative Examples 1 to 3 of the present specification deformed. For the Examiner's convenience, Applicants herein attach the same Exhibit A. Though the Office Action states there exists similar melt viscosities between the present invention and the cited reference (wherein the billet of Ebnesajjad '639 has a melt viscosity of 1.8×10^9 poise), the Ebnesajjad billet results in a block

deformation amount that is outside of the deformation as defined in the present claim 1 (based on extrapolation from Comparative Examples 1-3 that also employed static sintering techniques). Even Ebnesajjad '639 cannot achieve the unexpected results of the present invention.

Thus, Applicants respectfully submit that the present invention has achieved unexpected results, whereby these unexpected results rebuts any asserted *prima facie* case of obviousness based on the Ebnesajjad '639 reference.

Conclusion

Applicants respectfully submit that the present invention is patentably distinguishable from the cited Ebnesajjad '639 reference. First, the *In re Rose* case is inapplicable. Second, size involves more than a routine skill in the art, especially considering the problems involved when larger billets are produced. Third, a *prima facie* case of obviousness has not been formed since not all requirements for a *prima facie* case of obviousness have not been satisfied. And fourth, the present invention has achieved unexpected results that rebut any *prima facie* case of obviousness.

A full and complete response has been made to the Office Action. The Examiner is respectfully requested to pass the application to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the

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undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Exhibit A ✓